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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,212	10/04/2000	Deepak Gupta	JP920000252US1	8179

7590 12/01/2003

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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 12/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application No.

09/679,212

Applicant(s)

GUPTA, DEEPAK

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detain Action

1. This Office Action is in response to the Application SN 09/679,212 filed on 10/04/2000. Claims 1-24 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 1, 9 and 17 are rejected under 35 U.S.C. 102(a) as being anticipated by Shinomura et al. (US 6,108,709), herein after referred as Shinomura.**

4. As to claim 1, Shinomura teaches a system has an alternate forwarding function for sending the message to alternate receiver when communication is not established under a predetermined condition, comprising:

means for the sender to specify alternate recipients (a sender can specify or designate the terminal name, which specifies a user such as the user's name, user's account or address, the name of his or her terminal, or his or her nick name, that acts

Art Unit: 2141

as an alternate receiver in the "Alternate Name" input filed of Fig. 14) of an email message to be used in case the mail system can not deliver the message to the original recipient, i.e., the original receiver (Shinomura, Fig. 14 and corresponding text, C13: L43-54);

means for said email system to deliver the message to the specified alternate recipients in case it is unable to deliver to the original recipient (Shinomura, C15: L21-25 and C16: L58-64).

5. Claims 9 and 17 are corresponding method and computer program product claims of system claim 1; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura.**

8. As to claim 2, Shinomura teaches the invention substantially as claimed as discussed above; however, Shinomura does not explicitly teach that means for the sender to specify the alternative recipient is by addition of ARCPT (Alternate Recipient) parameter in said SMTP protocol.

Shinomura teaches a window (Fig. 14) containing a field "Alternate Name" for the sender to designate the terminal name, which specifies a user such as the user's name, user's account or address, the name of his or her terminal, or his or her nick name, that acts as an alternate receiver of an email message to be used in case the mail system can not deliver the message to the original recipient. Hence, Shinomura does teach an "Alternate Recipient" parameter embedded in the GUI (the panel of Fig. 14) to specify the alternative recipient for the system to use in case the mail system cannot deliver the message to the original recipient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Shinomura to include the ARCPT (Alternate Recipient) parameter in SMTP protocol for a sender to specify an alternate recipient because it would allow the system to expand the SMTP extensions (parameters) to automatic forward the message to the alternate recipients/receivers in case of inability to deliver to original.

9. Claims 10 and 18 are corresponding method and computer program product claims of system claim 2; therefore, they are rejected under the same rationale.

10. Claims 3-4, 11-12 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura, in view of McDowell et al. (US 6,438,583), herein after referred as McDowell.

11. As to claim 3, Shinomura teaches the invention substantially as claimed as discussed above; however, Shinomura does not explicitly teach that said means for delivering the message to the specified alternate recipients is an extension to the SMTP server to include automatic forwarding of the message to the alternate recipients in case of inability to deliver to original recipients.

In the related art, McDowell teaches a method and system for the re-routing of email sent to a prior address (or an address that is non-working, not available or temporarily inconvenient) to the new address of an intended recipient (i.e., an alternate recipient) through the SMTP implementation (McDowell, Abstract and C6: L20-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Shinomura and McDowell to implement SMTP extension to automatic forward the message to the alternate recipients/receivers in case of inability to deliver to original recipients because it would let the system to take the advantage of the SMTP extension implementation (either via software or hardware) to allow the sender to define a back-up transmission path to increase the probability that the message reaches the final intended destination on the selected path (i.e., through the alternate recipients/receivers) without much effort required of a user.

12. Claims 11 and 19 are corresponding method and computer program product claims of system claim 3; therefore, they are rejected under the same rationale.

13. As to claim 4, Shinomura-McDowell teaches the system as in claim 1, wherein means for specifying the alternate recipient can also be used by the recipient or the system administrator of the recipient server to forward emails to another address and alternate recipient on the recipient server shall hold priority over the one already in the email specified by the sender (McDowell, C7: L11-49 and L63-67, C8: L1-23).

14. Claims 12 and 20 are corresponding method and computer program product claims of system claim 4; therefore, they are rejected under the same rationale.

15. Claims 5-8, 13-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinomura, in view of Buckley (US 6,163,809).

16. As to claims 5-7, Shinomura teaches the invention substantially as claimed as discussed above; however, Shinomura does not explicitly teach that said means for the sender to specify notification (by addition of ALTERNATE keyword to the NOTIFY parameter) by said email system of successfully delivery to the alternate recipients on failure to deliver to original recipient and means for said email system to notify the sender based on the delivery (or non-delivery) of the message the alternate recipients.

In the related art, Buckley teaches a system and method for preserving delivery status notification wherein the sender defines delivery status notification options such as per-message options and/or per-recipient options (e.g., the option to identify for each recipient, i.e., both original recipients and alternate recipients, whether a message has been delivered or delayed, or whether delivery never occurred) through an extension of the SMTP implementation (i.e., by addition of ALTERNATE keyword to the NOTIFY parameter) (Buckley, C4: L13-24 and C7: L45-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Shinomura and Buckley to implement SMTP extension to notify the sender based on the delivery (non-delivery) of the message to the alternate recipients/receivers because it would let the system to take the advantage of the SMTP extension implementation (either via software or hardware) to allow the sender to specify and receive delivery status notifications as requested in order to prevent loss of information transmitting over the networks by keeping track of the delivery (or non-delivery) of the message (i.e., to keep track of whether the message reaches the final intended destination through the alternate recipients/receivers) without much effort required of a user.

17. Claims 13-15 and 21-23 are corresponding method and computer program product claims of system claims 5-7; therefore, they are rejected under the same rationale.

18. Claim 8 is a combination method claim of claims 2 and 6; therefore, it is rejected under the same rationale.

19. Claims 16 and 24 are corresponding method and computer program product claims of system claim 8; therefore, they are rejected under the same rationale.

20. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

Art Unit: 2141

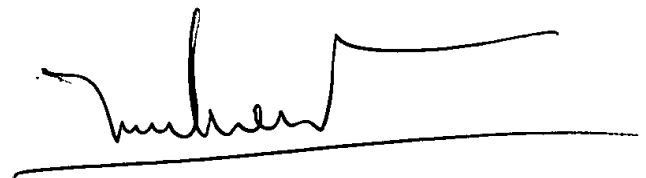
21. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

A handwritten signature in black ink, appearing to read 'Le Hien Luu', is written over a horizontal line.

LE HIEN LUU
PRIMARY EXAMINER